

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of **Semlyen et al.** )  
 )  
Serial No. **10/550,759 (from PCT/CA2004/000458)** )  
 )  
International Filing Date: **March 26, 2004** )  
 )  
For: **DIAGNOSIS OF DISEASE BY** )  
 **DETERMINATION OF ELECTRICAL** )  
 **NETWORK PROPERTIES OF** )  
 **A BODY PART** )

Commissioner for Patents  
P.O. Box 1450,  
Alexandria, VA 22313-1450

Dear Sir/Madam:

**DECLARATION UNDER 37 CFR 1.47**

I, Stephen M. Beney, hereby declare that:

1. I am a Registered Canadian Patent Agent (Registration Number 10,042), and a Registered United States Patent Agent (Registration Number 41,563).
2. I am a Patent Agent and Partner with Bereskin & Parr. I have been a Patent Agent for at least ten (10) years and a Partner with Bereskin & Parr for at least five (5) years. As part of my duties, I am familiar with matters relating to certain patent filings, and in particular, U. S. patent application, Serial No. 10/550,759 (from PCT/CA2004/000458). As such, based on my personal knowledge and a review of records in my possession and control, I have firsthand knowledge of the matters set out herein.

3. U. S. patent application, Serial No. 10/550,759 (from PCT/CA2004/000458), names Adam Semlyen and Milan Graovac as co-inventors.

4. The purpose of this declaration is to set forth proof of the circumstances of the refusal of Adam Semlyen to execute the appropriate declaration, as required under 37 CFR 1.47(a).

5. Adam Semlyen refuses to sign the appropriate declaration, despite requests to get him to do so.

6. I am informed by Z-Tech (Canada) Inc. and do verily believe that Adam Semlyen and Milan Graovac made the invention for and on behalf of the company. A copy of an assignment from the inventors to Z-Tech (Canada) Inc., and as executed by both Adam Semlyen and Milan Graovac is attached as Schedule "A" to this declaration.

7. I have correspondence in writing, by e-mail, from Adam Semlyen in regard to execution of a suitable declaration for application, serial number 10/550,759 (from PCT/CA2004/000458). He has informed in writing that he refuses to sign anything relating to the patent. I understand that the reason for refusing to execute the declaration is that he does not want to be burdened anymore with the legal and administrative processes involved in obtaining patents.

8. It is my belief and the best information of my firm and of Z-Tech (Canada) Inc. that the last known mailing address of Adam Semlyen is 2203-65 High Park Avenue, Toronto, Ontario, M6P 2R7, Canada.

9. Serial number 10/550,759 (from PCT/CA2004/000458) is the only patent application for Z-Tech (Canada) Inc. that names Adam Semlyen as an inventor. Both Adam Semlyen and Milan Graovac were active in the drafting, review and

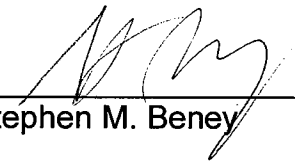
approval of the patent application that resulted in serial number 10/550,759 (from PCT/CA2004/000458). As this is the only application that Adam Semlyen is named as an inventor on for Z-Tech (Canada) Inc., he is fully aware of the invention and contents of the patent application that resulted in serial number 10/550,759 (from PCT/CA2004/000458).

10. After the filing of the international patent application, PCT/CA2004/000458, and upon presentation of the filed application and various forms for executing, including the US Declaration for Utility Application form, Adam Semlyen expressed to Z-Tech (Canada) Inc. his refusal to sign any forms having regard to the patent. Z-Tech (Canada) Inc. then asked co-inventor Milan Graovac, who is known to Adam Semlyen, to attempt to have Adam Semlyen execute the various forms for the international patent application, including the US Declaration for Utility Application for the present application.

11. On August 26, 2004, Z-Tech (Canada) Inc. provided me with an email from Milan Graovac that outlined that he was unsuccessful in getting Adam Semlyen to execute the various forms, including the US Declaration for Utility Application form for the present application. Adam Semlyen provided Milan Graovac with his reasons in an email to Milan Graovac dated August 24, 2004, that states that he finds "any involvement in legal or administrative processes related to the invention ... appear now burdensome to me" and "I would like not to have to read any correspondence related to it, much less be asked to sign anything in the future." A copy of these emails is attached as Schedule "B" to this declaration.

12. On February 3, 2005, Z-Tech (Canada) Inc. was able to have Adam Semlyen execute the assignment attached in Schedule "A". However, Z-Tech (Canada) Inc. agreed with Adam Semlyen that it would respect his wishes and not bother him further having regard to this patent application. Z-Tech (Canada) Inc. has instructed Bereskin & Parr to respect Adam Semlyen's wishes as well.

13. This statement is made by the undersigned who declares that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further, that these statements are made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of the Title 18 of the U.S. Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

  
\_\_\_\_\_  
Stephen M. Beney

July 3, 2007  
\_\_\_\_\_  
Date

## **Schedule "A"**

## UNITED STATES ASSIGNMENT

WHEREAS WE, **ADAM SEMLYEN** and **MILAN GRAOVAC**, whose full post office addresses are **2203-65 High Park Avenue, Toronto, Ontario, Canada M6P 2R7** and **41 Sylvan Valleyway, Toronto, Ontario, Canada M5M 4M4**, have invented certain new and useful improvements in an invention entitled **DIAGNOSIS OF DISEASE BY DETERMINATION OF ELECTRICAL NETWORK PROPERTIES OF A BODY PART** for which a Canadian patent application was filed on **March 26, 2004** as serial No. **2,462,157**, a PCT International Application was filed on **March 26, 2004** as International Application No. **PCT/CA04/000458**, and a regular U.S. patent application was filed on **March 26, 2004** as serial No. **10/809,473**.

AND WHEREAS, **Z-Tech (Canada) Inc.**, a corporation of **2 Berkeley Street, Suite 310, Toronto, Ontario, Canada M5A 4J5**, has acquired from us the whole right, title and interest for the United States of America and all other countries in and to the said invention and in and to any Letters Patent that may be obtained therefor, and in and to said application.

NOW THEREFORE, in consideration of the sum of One Dollar (\$1.00) and other good and valuable consideration, the receipt of all of which is hereby acknowledged, we, **ADAM SEMLYEN** and **MILAN GRAOVAC**, by these presents confirm that we have sold, assigned and transferred and do hereby sell, assign and transfer unto the said **Z-Tech (Canada) Inc.**, the full and exclusive right to the said invention in the United States of America and all other countries and the entire right, title and interest in and to any and all Letters Patent which may be granted therefor, and the entire right, title and interest in and to said application, and in and to any divisions, continuations, continuations-in-part and extensions of said application, together with the right to claim the benefit of the right of priority provided by the Patent Cooperation Treaty based on said application for United States Letter Patent.

We hereby authorize and request the Commissioner of Patents and Trademarks to issue said Letters Patent to said **Z-Tech (Canada) Inc.**, the assignee of the entire right, title and interest in and to the same, for its sole use and benefit,

and for the use and benefit of its successors and assigns, to the full end of the term for which Letters Patent may be granted as fully and entirely as the same would have been held by us had this assignment and sale not been made.

The undersigned hereby grant(s) the firm of Bereskin & Parr (Box 401, 40 King Street West, Toronto, Ontario, Canada M5H 3Y2) the power to insert on this assignment any further identification which may be necessary or desirable in order to comply with the rules of the United States Patent and Trademark Office for recordation of this document.

SIGNED this 3rd day of February, 2005, at

Xiaolin Wang  
Witness

Adam Semlyen  
ADAM SEMLYEN

SIGNED this 3rd day of February, 2005, at

Xiaolin Wang  
Witness

Milan Graovac  
MILAN GRAOVAC

We accept the assignment of this invention and all related patent applications and Letters Patent.

SIGNED this 3rd day of February, 2005, at

Xiaolin Wang  
Witness

[Signature]  
Z-TECH (CANADA) INC.  
By: [Signature] LA. ORGAN  
Title: Chief Medical Officer



## **Schedule "B"**

**Subject:** FW: Letter from Bereskin and Parr  
**Date:** Thursday, August 26, 2004 10:14 AM  
**From:** Ron Baker <rbaker@z-techinc.com>  
**To:** "Stephen M. Beney" <sbeney@bereskinparr.com>  
**Cc:** <rparr@bereskinparr.com>, 'Les Organ' <organl@z-techinc.com>  
**Category:** Client

Stephen,

We were unsuccessful with Dr. Semlyen. Please see messages from our "liaison" (a trusted colleague of Dr. Semlyen) and from Dr. Semlyen.

I have discussed this with Dr. Organ. If feasible, we would like to accede to Dr. Semlyen's wishes, remove him from the patent application and proceed.

Please contact me to discuss "where to from here" and next steps.

Thanks.

Ron

Ron Baker  
VP Operations  
Z-Tech (Canada) Inc.  
2 Berkeley Street, Suite 310  
Toronto, Ontario  
M5A 4J5  
Canada  
phone: 416-421-4788  
fax: 416-421-8180  
email: rbaker@z-techinc.com

-----Original Message-----

From: Milan Graovac [mailto:milan.graovac@utoronto.ca]  
Sent: August 25, 2004 4:14 PM  
To: Ron Baker  
Cc: Leslie Organ AOL  
Subject: FW: Letter from Bereskin and Parr

Hi Ron,

I have tried to persuade professor Semlyen to sign documents you gave me. Unfortunately he maintained position that regardless of the letter he does want to make any kind of commitment and insisted that he just does not want to sign anything, to the point that he does not care if his name is mentioned on the patent or not.

I asked him to summarize his position and email it to me (he did not want to get involved in correspondence with anyone from Z-Tech directly).

I do not feel that I have the way to persuade him to sign anything in the future.

Regards,

Milan

-----Original Message-----

From: Adam Semlyen [mailto:adam.semlyen@utoronto.ca]

Sent: Tuesday, August 24, 2004 4:29 PM

To: Milan Graovac

Subject: Re: Letter from Bereskin and Parr

Dear Milan,

As I tried to clarify to you in our telephone conversation, any involvement in legal or administrative processes related to the invention you referred to in your email appear now burdensome to me. I would like not to have to read any correspondence related to it, much less be asked to sign anything in the future.

I would prefer if from the company's end the action undertaken would be such as to completely leave me out from this invention. I believe in the value of the ideas it covers and hope they will prove to be successful but I do not wish to be formally part of the invention.

Hopefully, this way, our future conversations will be, as before, on less formal and more interesting topics.

Best greetings -- Adam